REMARKS

Claims 25 and 27-36 are pending. Claims 1-24 and 26 have been cancelled. Claim 27 was previously presented and remains unamended. New claims 28-36 have been added.

Support for the amendments to claim 25 may be found, *inter alia*, on page 8, lines 26-28 ("venlafaxine HCl"); page 5, lines 18-21 ("a polyol"); page 17, line 32 to page 18, line 5 ("calcium salt"); page 19, lines 1-4 (listing of lubricating materials); in Examples 1 and 2 ("polyvinylpyrrolidone polymer"); and page 5, lines 22-28 ("diameter from about 1 millimeter to about 3 millimeters and a length from about 1 millimeter to about 3 millimeters").

Claim 25, as amended, is restricted to compositions comprising: venlafaxine HCl as the active; specific compressible materials; specific lubricating materials; and specific binders. Without being bound by any particular theory, Applicant believes that compositions comprising the recited combination of compressible materials, lubricating materials, and binders are particularly suited to formulating hydrophilic compounds such as venlafaxine.

Support for new claim 28 may be found, *inter alia*, on page 6, lines 3-6.

Support for new claim 29 may be found, *inter alia*, on page 18, lines 17-22, where a variety of polyols are specifically listed. Such polyols include, for example, sorbitol, isomalt, maltitol, xylitol, lactitol, and erythritols. Polyols also include celluloses, such as microcrystalline celluloses, polydextrose, and sugars, such as sucrose. Support for claim 29 may also be found in the examples.

Support for new claim 30 may be found, *inter alia*, in the examples and on page 5, lines 26-28.

Support for new claim 31 may be found, *inter alia*, on page 18, lines 27-30.

Support for new claim 32 may be found, *inter alia*, on page 19, lines 1-9 and 22-26.

Support for new claim 34 may be found, *inter alia*, on page 23, lines 3-6.

Support for new claim 35 may be found, *inter alia*, on page 17, line 32 to page 18, line 5.

Support for new claim 36 may be generally found in the examples. The examples teach granulation and compression of the granulate into caplets.

The undersigned and the Applicant wish to thank Examiner Fubara for the cordial and productive interview of March 6, 2008. The Examiner's helpful comments and suggestions were instrumental in preparing this Amendment. During the interview, Applicant's representatives and the Examiner discussed the dissolution profiles of caplets/mini-tablets vs. regular tablets and

granules (in a capsule) that are shown in Exhibit A. The Examiner was not convinced that the dissolution profile for caplets/mini-tablets shown in Exhibit A would be observed across the board for all combinations of actives/compressible materials/lubricating materials/binders. Accordingly, Applicant's representatives agreed to at least consider either gathering dissolution profiles for other formulations comprising other actives or restricting the claims to the active contained in the formulation that yielded the dissolution profiles shown in Exhibit A, namely, venlafaxine.

I. *The rejection under 35 U.S.C. § 112, first paragraph should be withdrawn*

Claims 3-27 stand rejected under 35 U.S.C. § 112, first paragraph for the reasons set forth on pages 2 and 3 of the Office Action as allegedly failing to comply with the written description requirement. Specifically, the Examiner alleges that "[t]he specification as originally filed does not envision diameters in the range of about 1 millimeter to about 3 millimeters." Applicant respectfully disagrees.

Applicant offers that the invention claimed does not have to be described *in ipsis verbis* in order to satisfy the description requirement of § 112. *See, In re Wertheim et al.*, 541 F.2d 257, 265 (C.C.P.A. 1976) citing *In re Lukach*, 442 F.2d 967, 969 (C.C.P.A. 1971). The burden of showing that the claimed invention is not described in the specification rests on the U.S. Patent and Trademark Office ("the PTO") in the first instance, and it is up to the PTO to give reasons why a description not *in ipsis verbis* is insufficient." *Id.* In the instant case, the PTO has done nothing more than to argue lack of literal support, which is not enough. *Id.* Accordingly, the PTO has not met its burden and has not offered any reasons why a description not *in ipsis verbis* is insufficient. For at least this reason, the rejection under 35 U.S.C. § 112, first paragraph should be withdrawn.

The specification literally describes a caplet having a diameter from about 1 millimeter to about 7 millimeters and a length from about 1 millimeter to about 7 millimeters. *See* page 5, lines 22-26. The specification also literally describes a preferred diameter of the caplet that is about 3 millimeters and the length that is about 3 millimeters. *See* page 5, lines 26-28. In the instant case, the specification contains literal support for a broad range (*i.e.*, 1-7 mm in length and diameter) and values within that broad range (*i.e.*, 3 mm x 3 mm in length and diameter, respectively). Applicant asserts that diameter and length ranges of about 1 millimeter to about 3

millimeters are adequately described in the specification. Even though there is not *in ipsis verbis* description of diameter and length ranges of about 1 millimeter to about 3 millimeters, Applicant asserts that the specification conveys to the skilled artisan that the inventor, at the time the application was filed, had possession of the claimed invention since the specification adequately describes diameter and length ranges of about 1 millimeter to about 3 millimeters by reciting the broad ranges for length and width and values within those broad ranges. *See Id.* For at least this additional reason, the rejection under 35 U.S.C. § 112, first paragraph should be withdrawn.

Applicant asserts that new claims 28-36 comply with 35 U.S.C. § 112, first paragraph at least for the foregoing reasons.

II. *The rejection under 35 U.S.C. § 103(a) should be withdrawn*

Claims 3-27 stand rejected over U.S. Patent No. 4,053,632 to Carnmalm *et al.* (hereinafter "Carnmalm"); U.S. Patent No. 5,296,233 to Batista *et al.* (hereinafter "Batista"); U.S. Patent No. 5,869,097 to Wong *et al.* (hereinafter "Wong"); and U.S. Patent No. 5,541,210 to Cupps *et al.* (hereinafter "Cupps"). Applicant respectfully traverses this rejection and requests reconsideration and withdrawal thereof.

Applicant respectfully submits that the references of record do not teach or suggest all of the features of the pending claims.

Claim 25, the sole independent claim, is drawn to a pharmaceutical product comprising a therapeutically effective amount of venlafaxine HCl, at least one compressible material, at least one lubricating material, and a binder. The product is in the form of a caplet or mini-tablet having a diameter from about 1 millimeter to about 3 millimeters and a length from about 1 millimeter to about 3 millimeters.

As an initial matter, although some of the references cited may generically disclose antidepressants, none of the cited references specifically disclose venlafaxine HCl. And, it is well settled that a generic disclosure can not anticipate a species unless the species can be "at once envisaged" from the disclosure. *See Manual of Patent and Examination Procedure* § 2131.02. In addition, none of the cited references teach, suggest, or otherwise contemplate the specific combination of venlafaxine HCl, at least one compressible material, at least one lubricating material, and a binder. Finally, none of the references teach, suggest or otherwise contemplate a product, in the form of a caplet or mini-tablet, having a diameter from about 1

millimeter to about 3 millimeters and a length from about 1 millimeter to about 3 millimeters. Batista and Cupps, in fact, do not disclose any tablet size. In the Office Action, the Examiner acknowledges this. Further, Carnmelm discloses a tablet size (*i.e.*, 6-10 mm in diameter) that is outside the diameter recited in claim 25. Finally, Wong teaches, for example, an osmotic caplet that has a diameter of 8.5 mm at its center—again, outside the diameter recited in claim 25. *See* Example 10 of Wong. Accordingly, none of the references of record teach or suggest all of the features of the pending claims. The rejection should be withdrawn for at least this reason.

The Examiner has stated in at least two instances in the Office Action that, "[i]n the absence of factual evidence, [a] caplet having the recited dimensions of length and diameter is not inventive over the caplet of the prior art. . . ." Office Action at page 5. Applicant would like to point out that on January 14, 2005, Applicant submitted factual evidence that demonstrated that the unique properties of the presently claimed product are a result of the <u>size</u> of the dosing unit. Applicant offers that the factual evidence submitted is commensurate with the scope of claim 25. Accordingly, such data shows that the product recited in claim 25 is inventive over the prior art of record.

Briefly, on January 14, 2005, Applicant submitted comparative test data showing the desired delivery of venlafaxine HCl from the claimed caplets or mini-tablets in comparison with (i) a larger tablet and (ii) a capsule filled with granules, both of which were made from exactly the same components as the claimed caplets or mini-tablets. Applicant prepared an *in vitro* dissolution test to demonstrate the importance of the size of the caplets or mini-tablets on the desired dissolution profile. In particular, Applicant prepared a composition containing (all percentages herein are given as weight percent) 61.88% venlafaxine HCl, 16.21% glyceryl behenate, 16.21% microcrystalline cellulose, 4.38% ethyl cellulose, 0.88% magnesium stearate, and 0.88% purified talc. The ingredients were granulated and dried, then coated with a solution containing 5.00% ethyl cellulose, 0.50% triethyl citrate, and 94.50% isopropyl alcohol. The composition was then divided into three portions. A first portion was loaded (as granules) into a capsule. A second portion was tableted to a size of 11 mm. The third portion was compressed into caplets or mini-tablets having a size of 3 mm in length and diameter. The three products were then tested for their dissolution profile in 0.1N HCl using paddles at 100 rpm with a volume of 1000 mL. The results of the dissolution are shown in the attached chart (Exhibit A). As can be seen from the chart, Applicant found that the larger tablets and the capsules containing the

granules exhibited immediate release profiles. Surprisingly, the caplets or mini-tablets having the claimed size exhibited an extended release profile. In Exhibit A, the line that corresponds to the caplets or mini-tablets is labeled "CR Venlafaxine HCl 37.5 mg KORTABS." Accordingly, the data show *identical compositions* in granular and tablet form that have significantly different release profiles relative to the *identical composition* in the form of caplets or mini-tablets within the size range recited in the amended claims. In sum, the factual evidence that the Applicant has submitted demonstrated that the unique properties of the presently claimed invention are a result of the size of the dosing unit. The fact that all three dosage forms (*i.e.*, capsule, tablet, and caplet/mini-tablet) were made using the same composition shows that the dissolution profile is *not* a function of the formulation, bur rather, varies depending on the size of the tablet or caplet/mini-tablet. On the basis of this factual evidence, the Examiner should withdraw the rejection of claim 25, from which all claims ultimately depend. Applicant asserts that new claims 28-36 are patentable over the art of record at least for the foregoing reasons.

CONCLUSION

Entry of the foregoing and prompt and favorable consideration of the subject application on the merits are respectfully requested. Applicant respectfully submits that the pending claims are in condition for allowance.

Respectfully submitted,

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